

REMARKS/ARGUMENTS

The Office Action mailed January 21, 2004 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-3 and 8-12.

35 USC 103 Rejection

In numbered paragraph 3 of the Office Action mailed January 21, 2004 claims 1-3 and 8-12 were rejected under 35 USC 103(a) as allegedly being unpatentable over the Boppart et al reference (U.S. Patent No. 6,485,413) in view of the Von Bargen reference (U.S. Patent No. 5,708,273).

Applicants have amended the two independent claims, claims 1 and 12, in the application and therefore have effectively amended all of the claims presented for examination. Applicants respectfully submit that the claims presented for examination are patentable over the Boppart et al reference and the Von Bargen reference and any legitimate combination of the Boppart et al reference and the Von Bargen reference.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) include "Ascertaining the differences between the prior art and the claims at issue." The differences between the Boppart et al reference and Applicants' invention defined by the amended claims include the following elements that are not shown by the Boppart et al reference:

"a probe with a needle that is inserted into the tissue and that directs said emission signal to the probe and through the needle to the tissue for characterizing the tissue,"

"a transmission system including an emission optical fiber connected to said laser means, to said probe, to said needle, and to

said emission optical detector that transmits said emission signal to said probe, to said needle, and from said probe to the tissue for characterizing the tissue, and from the tissue to said needle, to said probe and to said emission optical detector,”

“a reference optical fiber connected to said laser means, to said probe, and to said reference optical detector that transmits said reference signal to said probe and from said probe to said reference optical detector,” or

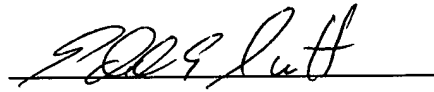
“a compensation system that utilizes said reference signal to correct said emission signal for characterizing the tissue for the optical fluctuations.”

The Von Barga reference does not provide the missing elements of Applicants’ amended claims. The Von Barga reference uses a probe 18 that receives a flow of a sample. There is no legitimate combination of the Bopp et al reference and the Von Barga reference that would produce the combination of elements of Applicants’ amended claims. Further, there is no teaching of combining the Bopp et al reference and the Von Barga reference to meet Applicants’ amended claims.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated January 21, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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